

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

James F. Flack

Application No.: 09/328,053

Confirmation No.: 6268

Filed: June 8, 1999

Art Unit: 2629

For: MOTION DRIVEN ACCESS TO OBJECT
VIEWERS

Examiner: Kent Wu Chang

REPLY BRIEF UNDER 37 C.F.R. §41.41

MAIL STOP: APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer ("Answer") mailed on May 23, 2008 in the above-identified application, and is in furtherance of the Notice of Appeal filed on December 20, 2007 and the Appeal Brief filed on February 20, 2008. The Appellant respectfully submits that the Answer is premised on an incorrect application of the law regarding obviousness and mischaracterization of the cited references.

I. STATUS OF CLAIMS

The application was initially filed with 99 claims. Claims 1-99 are pending in this application. Claims 1-99 stand rejected under 35 U.S.C. § 103(a). Claims 1-99 are the subject of the present appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3, 6-16, 19-32, 34-45, 47-50, 52-55, 58-68, 71-83, 86-96, and 99 are unpatentable under 35 U.S.C. §103(a) over Motosyuku et al. (U.S. Patent No. 5,602,566) in view of Ball (U.S. Patent No. 5,686,942).

2. Whether claims 4, 5, 33, 56, 57, 84, and 85 are unpatentable under 35 U.S.C. §103(a) over Motosyuku in view of Ball, and further in view of Kang (U.S. Patent No. 6,009,210).

3. Whether claims 17, 18, 46, 51, 69, 70, and 97-98 are unpatentable under 35 U.S.C. §103(a) over Motosyuku in view of Ball, and further in view of Detlef (U.S. Patent No. 6,178,403).

III. ARGUMENTS IN REPLY TO EXAMINER'S ANSWER

The Answer Incorrectly Asserts that the Cited Reference Discloses Each and Every Element of the Claims

Applicants refer to the legal standards for obviousness as summarized in its Appeal Brief. Under these legal standards, the applicant's claims are not obvious.

Applicant submits that the Examiner does not identify prior art references, or a combination thereof, that discloses all the elements of the pending claims. Moreover, the Examiner has failed to identify a sufficient reason why a person of ordinary skill in the art would find the pending claims obvious over Motosyuku, Ball, or the combination of Motosyuku and Ball. Furthermore, the Examiner has failed to identify a sufficient reason why a person of ordinary skill in the art would find the pending claims obvious over Motosyuku, Ball, Kang, Detlef, or the combination of Motosyuku, Ball and Kang, or the combination of Motosyuku, Ball and Detlef.

Therefore, the claims on appeal should be allowed.

Applicant further refers to the additional arguments made in its Appeal Brief, which will not be repeated herein, but which the applicant continues to maintain in view of the Examiner's Answer.

1. The Answer incorrectly asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Motosyuku to map the entire information content to the virtual desktop so as to enable the user to access the entire information content via the input system" (Page 7 of the Examiner's Answer mailed May 23, 2008).

In fact, appellant submits that Motosyuku teaches away from "mapping the entire content onto a virtual desktop" for at least the following stated reasons.

Specifically, modifying the Motosyuku device by "mapping the entire content onto a virtual desktop" will render the Motosyuku device inoperable for its intended purpose. Motosyuku discusses a small-sized information processor which is being used while being held in one hand, and which can scroll a display screen in accordance with a tilt. The scroll function enabled by a tilt as taught by Motosyuku enables a user of the device to scroll through a text document which cannot be displayed on the display screen in its entirety and be visible to the user (see, FIG. 2-3 of Motosyuku).

If Motosyuku's device were to "map the entire content onto a virtual desktop", the text (e.g., the text of FIG. 2-3 of Motosyuku) would likely be shrunken to a degree such that they are not visible to the user of the device thus rendering Motosyuku's device non-functional.

Further in Motosyuku:

"As illustrated in FIG. 2 the display unit 106 reads one frame of the display data 202 stored in the display storage unit 105, ..." (Motosyuku, Col. 3, lines 17-19)

Motosyuku specifically states that only one frame of the display data is read by the display unit. Furthermore, the purpose of the scrolling feature discussed by Motosyuku is

intended to obviate the need to "map the entire content onto a virtual desktop" for the user to view the entire content since the user of Motosyuku's device can "scroll" through a document.

Additionally, appellant notes that the Examiner admits that Motosyuku does not clearly point out that the computer maps the information content to the virtual desktop (Page 4 of the Examiner's Answer mailed May 23, 2008). As Ball does not cure the deficiency, the Examiner relies on the alleged ordinary skill in the art at the time the invention was made. This allegation is unsubstantiated.

Therefore, neither Motosyuku, nor Ball, nor the combination of Motosyuku and Ball, teaches, suggests, or discloses "mapping the entire content onto a virtual desktop". Thus, the Board should reverse the Examiner's rejections.

2. The Answer also incorrectly asserts that Motosyuku teaches controlling the scroll function based on the "movement of a display device", and Ball teaches controlling the scroll function based on the "translational movement of the input device", wherein using translational movement as taught by Ball to replace the rotational movement in the device of Motosyuku and Ball meets all of the limitations as claimed" (Page 7 of the Examiner's Answer mailed May 23, 2008).

In fact, Motosyuku only discusses using a tilt sensor to detect the tilt angle of the small-sized information processor (Col. 3, lines 30-32). The Answer has inaccurately correlated "tilt angle detection" with "translational movement tracking".

Appellant would like to emphasize that, in fact, Motosyuku merely determines whether the tilt angle of the device is less than or greater than 10 degrees. If the tilt angle is less than 10 degrees, the display screen scrolls one line. If the tilt angle is greater than 10 degrees, the display screen scrolls two lines (Motosyuku, Col. 4, lines 42-48). There is no indication that "movement is tracked" in the device of Motosyuku.

Furthermore, since the tilt angle is detected by a tilt sensor in Motosyuku, it is inconceivable that motion can also be detected via the tilt sensor.

For example, in Motosyuku:

*"If necessary, the processing unit 101 in FIG. 1 can read the tilt angle from the tilt sensor 104 through the bus."
(Motosyuku, Col. 3, lines 64-66)*

Furthermore, Ball discusses a system that tracks the movement of the tip of a human's nose to move a cursor (Ball, Col. 7, lines 3-4). The Examiner has, in the Answer, in accurately characterized "tracking the movement of the tip of a nose" as tracking "translational movement of the input device".

The Examiner fallaciously asserts in the Answer that the Appellant's arguments against the references individually are unpersuasive (Page 8 of The Examiner's Answer mailed May 23, 2008). Since the Examiner has inaccurately interpreted the teachings of both Motosyuku and Ball, there is no logical manner in which the teachings of Motosyuku and Ball can be combined to teach the subject matter as recited in the Appellant's claims.

Therefore, the Examiner has not established a *prima facie* case of obviousness with regard to claims 31-3, 6-16, 19-32, 34-45, 47-50, 52-55, 58-68, 71-83, 86-96, and 99. The rejections under 35 U.S.C. §103(a) for claims 31-3, 6-16, 19-32, 34-45, 47-50, 52-55, 58-68, 71-83, 86-96, and 99 are thus improper and reversal of the Examiner's rejection of these claims by the Board is thus respectfully requested.

Kang fails to cure the deficiencies of Motosyuku and Ball in order to support a 35 U.S.C. §103(a) rejection of claims 33, 56, 57, 84, and 85.

Detlef fails to cure the deficiencies of Motosyuku and Ball in order to support a 35 U.S.C. §103(a) rejection of claims 46, 51, 69, 70, and 97-98.

Therefore, 35 U.S.C. §103(a) rejections of claim 4, 5, 17, 18, 33, 46, 51, 56, 57, 69, 70, 84, 85, and 97-90 are improper for at least the reasons discussed above and for the additional features of these claims. Accordingly, the Board should reverse the rejection of these claims.

IV. CONCLUSION

Each of pending claims 1-99 has been improperly rejected for numerous reasons. One reason is that the applied references do not teach or suggest all of the features of each of claims 1-99. Therefore, the Examiner has failed to make a *prima facie* case of obviousness of each claim, and the Examiner thus cannot reject the claims under § 103(a). Each pending claim has been improperly rejected for at least the additional reason that each pending claim is non-obvious to a person of ordinary skill in the pertinent art under the statutory language of 35 U.S.C. § 103(a), as analyzed according to the framework set forth by the Supreme Court. Accordingly, the Board should reverse the Examiner's rejections of pending claims 1-99.

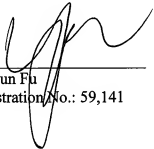
III. CONCLUSION

In view of the foregoing remarks, Appellant submits that all of the pending claims are in condition for allowance and patentably defined over the prior art, and urge the Board to overturn the Examiner's rejections.

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Respectfully submitted,

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